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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,548	08/08/2001	Shoukat Dedhar	KINE001CIP4	5127
24353	7590	03/15/2006	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			CHEN, SHIN LIN	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,548

Applicant(s)

DEDHAR ET AL.

Examiner

Shin-Lin Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' amendment filed 12-16-05 has been entered. Claim 3 has been amended. Claims 3 and 4, and SEQ ID Nos. 6 and 18, are pending and under consideration.

Priority

A search through the sequence database shows that the nucleotide sequence of SEQ ID No. 18 has not been disclosed in Application No. 08/752,345, filed 11-19-96, and provisional application 60/009.074, filed 12-21-95. Therefore, the effective priority date for SEQ ID No. 18 is the filing date of parent application 08/955,841, filed 10-21-97.

Applicants argue that the priority application states "screens aimed at DNA, RNA or ILK structural components e.g. antisense ILK (i.e. synthetic DNA oligonucleotide comprising the complementary nucleotide sequence of the ILK coding region, designed to specifically target the ILK mRNA complement", and the complement to SEQ ID No. 18 is provided in the sequence list (amendment, p. 7). This is not found persuasive because the priority application only broadly refers to antisense oligonucleotide comprising the complementary nucleotide sequence of the ILK coding region but fails to specifically disclose the particular sequence of SEQ ID No. 18. The priority application only discloses the sequence of full-length ILK cDNA sequence but fails to disclose each of the particular antisense oligonucleotide sequence (or sense oligonucleotide sequence) that is of interest. The disclosed ILK cDNA sequence has 1786 nucleotides and there are thousands of different combinations of antisense oligonucleotide sequences that can be anticipated. A broad statement of "antisense oligonucleotide comprising the complementary nucleotide sequence of the ILK coding region" does not render one of ordinary skill to anticipate

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which particular antisense oligonucleotide sequence is of interest. Thus, the priority date of Application No. 08/752,345, filed 11-19-96, and provisional application 60/009.074, filed 12-21-95, remain denied.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 3 and 4 remain rejected under 35 U.S.C. 102(a) as being anticipated by Dedhar et al., 1997 (WO 97/23625 A1, computer printout page 4, 5) and is repeated for the reasons set forth in the preceding Official action mailed 6-28-05. Applicant's arguments filed 12-16-05 have been fully considered but they are not persuasive.

Applicants argue that the present application is entitled to the priority date of December 21, 1995, thus, the cited art is rendered moot (amendment, p. 7). This is not found persuasive because of the reasons set forth in the preceding Official action mailed 6-28-05. As discussed above, the priority date of Application No. 08/752,345, filed 11-19-96, and provisional application 60/009.074, filed 12-21-95, remain denied, therefore, the claims remain rejected under 35 U.S.C. 102(a).

3. Claims 3 and 4 remain rejected under 35 U.S.C. 102(a) as being anticipated by Adams et al., April 1997 (EST Accession No. AA295328, computer printout page 2) and is repeated for

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the reasons set forth in the preceding Official action mailed 6-28-05. Applicant's arguments filed 12-16-05 have been fully considered but they are not persuasive.

Applicants argue that the present application is entitled to the priority date of December 21, 1995, thus, the cited art is rendered moot (amendment, p. 7). This is not found persuasive because of the reasons set forth in the preceding Official action mailed 6-28-05. As discussed above, the priority date of Application No. 08/752,345, filed 11-19-96, and provisional application 60/009.074, filed 12-21-95, remain denied, therefore, the claims remain rejected under 35 U.S.C. 102(a).

4. Claims 3 and 4 remain rejected under 35 U.S.C. 102(a) as being anticipated by Hillier et al., August 1997 (EST Accession No. AA135079, computer printout page 6, 7) and is repeated for the reasons set forth in the preceding Official action mailed 6-28-05. Applicant's arguments filed 12-16-05 have been fully considered but they are not persuasive.

Applicants argue that the present application is entitled to the priority date of December 21, 1995, thus, the cited art is rendered moot (amendment, p. 7). This is not found persuasive because of the reasons set forth in the preceding Official action mailed 6-28-05. As discussed above, the priority date of Application No. 08/752,345, filed 11-19-96, and provisional application 60/009.074, filed 12-21-95, remain denied, therefore, the claims remain rejected under 35 U.S.C. 102(a).

It should be noted that each antisense oligonucleotide sequence is a distinct invention. The "Decision of Petition" mailed 6-2-05 states "It is thus proper for the Office to set forth a restriction requirement to a single invention. Because the oligonucleotides lack "unity of

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invention”, per 803.02, election of species practice is not required. The inventions are distinct” (see page 5, lines 7-10). Although examination of SEQ ID No. 6 and 18 is granted in the decision of petition, however, it does not mean that the remaining SEQ ID Nos. in the claim would rejoin once the oligonucleotides SEQ ID No. 6 and 18 are allowable.

Conclusion

No claim is allowed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (571) 272-0726. The examiner can normally be reached on Monday to Friday from 9:30 am to 6 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for this group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Shin-Lin Chen, Ph.D.



SHIN-LIN CHEN
PRIMARY EXAMINER